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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COURSON, TANIA C

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,051

Applicant(s)

JIMENEZ ET AL.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-6, 9-10, 12, 23-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over West (US Des. 244,090) in view of Smyj (US 6,360,448 B1).

West discloses a measuring device with an upright grip comprising:

- a) an elongated finger-resting surface (Fig. 1);
- b) an elongated upstanding section projecting upwardly from said finger-resting surface (Fig. 3);
- c) an elongated scale-supporting section coupled to and extending along said upstanding section (Fig. 1) with said upstanding section being positioned between said scale-supporting section and said finger-resting surface (Fig. 3), said scale-supporting section being inclined with respect to a guiding device supporting surface (Fig. 3);
- d) wherein said finger-resting surface is substantially flat (Fig. 3);
- e) wherein said finger-resting surface, said upstanding section, and said scale supporting section are integrally formed as a unitary, one-piece element (Fig. 3);

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- f) a substantially flat contact surface (Fig. 3) positioned beneath said finger-resting surface, said upstanding section, and said scale supporting section to permit smooth application of said guiding device on the working surface (Fig. 3);
- g) wherein said contact surface includes an elongated recess (Fig. 2);
- h) wherein said upstanding section is a wall having a first side (Fig. 3) and a second side facing said finger-resting surface (Fig. 3), with said first side being inclined with respect to said scale-supporting section (Fig. 3);
- i) wherein said guiding device has a generally T-shaped cross-section (Fig. 3);
- j) wherein said upstanding section has a closed free end that contains no upwardly projecting openings (Fig. 3);
- k) wherein said finger-resting surface is substantially flat (Fig. 3) and is substantially parallel to a first bottom surface positioned beneath said finger-resting surface (Fig. 3), and;
- l) wherein said scale-supporting section has a first section end that forms a first free edge (Fig. 3) for placement against an item to be measured, said scale-supporting section having a second section end that extends to and is connected to said upstanding section (Fig. 3), said scale-supporting section has a scale-supporting surface that extends continuously between said first section end and said second section end, and said scale-supporting surface being inclined from said first section end to said second section end (Fig. 3).

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West does not disclose an elongated first scale made of metal having a lower surface and an upper surface, said lower surface being rigidly and unreleasably attached to a scale-supporting section and said upper surface having first indicia to indicate predetermined lengths along said first scale and said first scale having a non-metallic coating on said upper surface

Smyj teaches a measuring device that consists of an elongated first scale (Fig. 1, tape 10 with calibrated edge 20) made of metal (column 3, lines 36-38) having a lower surface and an upper surface (Fig. 1), said lower surface being rigidly and unreleasably attached to a scale-supporting section (column 4, lines 30-33) and said upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 1, tape 10 with calibrated edge 20) and said first scale having a non-metallic coating on said upper surface (Fig. 2, overlay 60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the measuring device with an upright grip of West, so as to include a first scale having indicia, as taught by Smyj, so as to provide a variety of scales for measuring items.

With respect to the term “substantially” the examiner understands the term “substantially” to be defined as “largely” or “mainly”.

With respect to the intended use of the apparatus, e.g. permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement and being configured to be placed against a substantially flat working

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surface: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

3. Claims 4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over West and Smyj, as applied to claims 1-3, 5-6, 9-10, 12, 23-24 and 28 as stated above, and further in view of Russo (US 1,091,461).

West and Smyj disclose a measuring device with an upright grip as stated above in paragraph 2.

West and Smyj do not disclose a finger-resting surface, an upstanding section and a scale supporting section formed of plastic and a contact surface including a second indicia printed and indicating predetermined lengths along said contact surface

Regarding claim 4: West and Smyj disclose the finger-resting surface, the upstanding section and the scale supporting section made of a material (Fig. 1). The particular type of material used to make the surface and sections, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Russo teaches a measuring device that consists of a contact surface including a second indicia printed and indicating predetermined lengths along said contact surface (Fig. 5, face 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the a measuring device with an upright grip of West and Smyj, so as to include a contact surface including a second indicia, as taught by Russo, so as to provide additional measuring means for increasing the use of the device.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over West and Smyj, as applied to claims 1-3, 5-6, 9-10, 12, 23-24 and 28 as stated above, and further in view of Okamoto (JP-05139089).

West and Smyj disclose a measuring device with an upright grip as stated above in paragraph 2.

West and Smyj do not disclose a second side including a plurality of ribs.

Okamoto teaches a measuring device that consists of a second side including a plurality of ribs (Fig. 3, ribs 33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the measuring device with an upright grip of West and Smyj, so as to include a second side including a plurality of ribs, as taught by Okamoto, so as to provide a means for increasing grip control of the device.

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5. Claims 13-15, 17, 19-20, 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over West in view of Smyj.

West discloses a measuring device with an upright grip comprising:

- a) an elongated, first portion having a finger-resting surface (Fig. 1) and a bottom surface opposite to said finger-resting surface (Fig. 3);
- b) an elongated, second portion extending along said first portion, said second portion having an upstanding section and an inclined scale-supporting section (Fig. 3), said upstanding section projecting upwardly from said finger-resting surface (Fig. 3) and having an uppermost free end (Fig. 3), said upstanding section being positioned between said scale-supporting section and said first portions (Fig. 3), said first and second portions having a generally T-shaped cross-section (Fig. 3);
- c) said bottom surface of said first portion being configured to be placed against a substantially flat working surface (Fig. 2), and said upper surface of said scale supporting section being inclined with respect to the working surface (Fig. 3);
- d) said scale-supporting section having an innermost edge further from the working surface than an outermost edge of said scale-supporting section (Fig. 3);
- e) wherein each of said finger-resting surface and said first bottom surface of said first portion is substantially flat (Fig. 3), and said finger-resting surface is substantially parallel to said first bottom surface (Fig. 3);
- f) wherein said first portion and said second portion are integrally formed as a unitary, one-piece element (Fig. 3);

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- g) wherein said upstanding section is a wall having a first side (Fig. 3) and a second side facing said finger-resting surface (Fig. 3), with said first side being inclined with respect to said scale-supporting section (Fig. 3);
- h) wherein said upstanding section includes a means for gripping said upstanding section by fingers of a user of said device (Fig. 3);
- i) wherein said finger-resting surface is substantially flat (Fig. 3);
- j) wherein said scale-supporting section has a first section end that forms a first free edge (Fig. 3) for placement against an item to be measured, said scale-supporting section having a second section end that extends to and is connected to said upstanding section (Fig. 3), said scale-supporting section has a scale-supporting surface that extends continuously between said first section end and said second section end, and said scale-supporting surface being inclined from said first section end to said second section end (Fig. 3).

West does not disclose an elongated first scale made of metal having a lower surface rigidly and unreleasably attached to a scale-supporting section and an upper surface having first indicia to indicate predetermined lengths along said first scale, said elongated scale having an innermost edge and an outermost edge remote from said innermost edge.

Smyj teaches a measuring device that consists of an elongated first scale (Fig. 1, tape 10 with calibrated edge 20) made of metal (column 3, lines 36-38) having a lower surface (Fig. 1) rigidly and unreleasably attached to a scale-supporting section (column 4, lines 30-33) and an

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upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 1, tape 10 with calibrated edge 20) and said elongated scale having an innermost edge and an outermost edge (Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the measuring device with an upright grip of West, so as to include a first scale having indicia, as taught by Smyj, so as to provide a variety of scales for measuring items.

With respect to the term “substantially” the examiner understands the term “substantially” to be defined as “largely” or “mainly”.

With respect to the intended use of the apparatus, e.g. permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement and being configured to be placed against a substantially flat working surface: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

6. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over West and Smyj, as applied to claims 13-15, 17, 19-20, 25 and 29 as stated above, and further in view of Russo.

West and Smyj disclose a measuring device with an upright grip as stated above in paragraph 5.

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West and Smyj do not disclose a first portion and a second portion formed of plastic and a contact surface including a second indicia printed and indicating predetermined lengths along said contact surface

Regarding claim 16: West and Smyj disclose the first and second portions made of a material (Fig. 1). The particular type of material used to make the portions, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Russo teaches a measuring device that consists of a contact surface including a second indicia printed and indicating predetermined lengths along said contact surface (Fig. 5, face 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the a measuring device with an upright grip of West and Smyj, so as to include a contact surface including a second indicia, as taught by Russo, so as to provide additional measuring means for increasing the use of the device.

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7. Claims 21-22, 26-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over West in view of Troyer et al. (US 4,149,320).

West discloses a measuring device with an upright grip comprising:

- a) an elongated finger-resting surface (Fig. 1);
- b) an elongated upstanding section projecting upwardly from said finger-resting surface (Fig. 3);
- c) an elongated scale-supporting section coupled to and extending along said upstanding section (Fig. 1) with said upstanding section being positioned between said scale-supporting section and said finger-resting surface (Fig. 3), said scale-supporting section being inclined with respect to a guiding device supporting surface (Fig. 3);
- d) said upstanding section has a closed free end that contains no upwardly projecting openings (Fig. 1);
- e) wherein said finger-resting surface is substantially flat and is substantially parallel to a first bottom surface positioned beneath said finger-resting surface (Fig. 3);
- f) wherein said scale-supporting section has a first section end that forms a first free edge (Fig. 3) for placement against an item to be measured, said scale-supporting section having a second section end that extends to and is connected to said upstanding section (Fig. 3), said scale-supporting section has a scale-supporting surface that extends continuously between said first section end and said second section end, and said scale-supporting surface being inclined from said first section end to said second section end (Fig. 3).

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West does not disclose an elongated first scale having a lower surface and an upper surface, said lower surface being rigidly and unreleasably attached to a scale-supporting section and said upper surface having first indicia to indicate predetermined lengths along said first scale.

Troyer et al. teaches a measuring device that consists of an elongated first scale (Fig. 1, tape 1) having a lower surface and an upper surface (Fig. 1), said lower surface being rigidly and unreleasably attached to a scale-supporting section (column 9, lines 41-44) and said upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 1, indicia 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the measuring device with an upright grip of West, so as to include a first scale having indicia, as taught by Troyer et al., so as to provide a variety of scales for measuring items.

With respect to the term “substantially” the examiner understands the term “substantially” to be defined as “largely” or “mainly”.

With respect to the intended use of the apparatus, e.g. permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement and being configured to be placed against a substantially flat working surface: It has been held that a recitation with respect to the manner in which a claimed apparatus

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is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Response to Arguments

8. Applicant's arguments filed on June 4, 2003, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

9. With respect to the term “substantially”, the examiner has reviewed the document, *Verve LLC v. Crane Cams, Inc. et al.*, 65 USPQ 2nd 1051 (Fed. Cir. 2002), previously provided by the applicant's representative and does not find the term “substantially”, nor the associated claims in which the term appears, to render the claim(s) indefinite, as is the subject of the case. Instead, the examiner understands the term “substantially” to be defined as “largely” or “mainly” in order for it to be read upon the applicant's Figures 19, 21 and 23- 27 regarding a “substantially flat finger-resting surface” and “a finger-resting surface is substantially parallel to a bottom surface” and Figures 1-4, 10-11, 17-18 and 22-25 regarding a “substantially flat contact surface”.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose measuring devices with guards and scales with adhesives:

Fischer et al. (US Des.386,316)

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Lewis (US Des.364,177)

Schworer (US 5,653,415)

Wagner et al. (US 5,012,590)

Huber (US 2,932,897)

Jones (US 2,645,019)

Lawrence (US 703,208)

Savidge (US 563,510)

Kaufmann (DD 261829 A)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
July 29, 2003